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EXAMINER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

Applicant's response filed on 6/30/2009 has been fully considered but is not persuasive.

Specifically, applicant argues that the process of making the polymer in the present product-by-process claims clearly provides for a different product as evidenced by the 37 CFR 1.132 declarations filed on 12/21/2007 and 3/3/2009.

With respect to the declaration filed on 12/21/2007, two of the three chromatogram charts show two elution times in both the inventive and comparative example. Therefore, it has not been established that the arguably critical effect of two elution times (and thereby arguably improved scrub resistance) is necessarily absent in the disclosure of Friel which does not include a step-wise addition of initiator.

With respect to the declaration filed on 3/3/2009, the data in Table 2 of the declaration only shows criticality with respect to scrub resistance of paint, however, the inconsistent amounts of rheology modifier in the examples make the examples improper side-by-side examples. Thus, it is impossible to tell whether the scrub resistance properties of the inventive and comparative examples are dependent on the process. As discussed in the Examiner's Answer mailed on 7/10/2006 and affirmed by the BPAI on 6/28/2007, to clearly establish the insignificance of the type of rheology modifier and that the inventive and comparative data are proper side-by-side examples, such must be clearly supported with factual evidence.

Furthermore, the inventive and comparative data of the declaration and specification have been fully considered and are not found to be reasonably commensurate in scope with the claimed invention. The amount of total initiator (for claim 1 only) and the amount of initiator used in the first 10 wt % of monomer conversion is still not reasonably commensurate in scope

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with the presently claimed process ranges. Case law holds that whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range (i.e., scope). *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980), MPEP 716.02(d). Given that the amounts of initiator are important in the presently claimed process and further given that applicant has not shown that improved scrub resistance properties (which are arguably due to multiple elution times in GPC-MALS) are had throughout the presently claimed amount ranges, criticality for the entire scope of the presently claimed process on the final product cannot be supported.

Specifically, concerning claim 1, the data only includes 0.3-0.35 wt % total initiator wherein the claim requires 0.3-0.4 wt % total initiator. Furthermore, the exemplified amounts of initiator added during the first 10 wt % of monomer conversion (0.05, 0.03, and 0.10) are not reasonably commensurate in scope with claimed less than 0.15 wt %. Concerning claim 2, the exemplified amounts of initiator added during the first 10 wt % of monomer conversion (20, 23, 20, 10, 35, and 22.2 wt %) are not reasonably commensurate in scope with claimed less than half (i.e., 50 wt %). It is noted that the emulsion polymer and type and amount of neutralize is reasonably commensurate in scope with the scope of the claims. There is no evidence of record to show that the amounts outside of the inventive examples and within the claimed range would also exhibit improved different properties.

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/V.N./

Examiner, Art Unit 1796

/David Wu/

Supervisory Patent Examiner, Art Unit 1796